

REMARKS

1. In response to the Office Action mailed March 16, 2006, Applicants respectfully request reconsideration. Claims 1-46 were originally presented for examination. Claims 1-46 were rejected in the outstanding Office Action. Claims 1, 5, 6, 9, 15, 18, 22, 30, 32, 37, 41, 42, and 44-46 have been amended. Claims 4, 10, 26, and 35 have been canceled. No claims have been added. Thus, upon entry of this paper, claims 1-3, 5-9, 11-25, 27-34, and 36-46 will be pending in this application. Of these forty-two (42) claims, six (6) claims (claims 1, 15, 18, 22, 32 and 42) are independent. Based on the above Amendments and following Remarks, Applicants respectfully request that the outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.
3. Applicants acknowledge receipt of the form PTO-1449's filed by Applicants on October 14, 2003 and February 24, 2005 which have been initialed by the Examiner indicating consideration of the references cited therein.
4. Applicants confirm that the Information Disclosure Statement filed on September 19, 2005 does not belong to the above-referenced application. Please note that upon review of the file in PAIR, that the Information Disclosure Statement referenced should be placed in U.S. Application No. 10/695,250.

Claim Rejections

5. Independent claims 1, 22 and 32 and dependent claims 4-14, 25-31 and 35-41 have been rejected under 35 U.S.C §102(a) as being anticipated by U.S. Patent No. 5,586,271 to Parrett (hereinafter "Parrett"). Independent claims 15 and 42 and dependent claims 2, 3, 16-21, 23, 24, 33, 34 and 43-46 have been rejected under 35 U.S.C §103(a) as being unpatentable over Parrett further in view of U.S. No. 6,414,533 to Graves (hereinafter,

“Graves”). Based on the above Amendments and following Remarks, Applicants respectfully request that these rejections be reconsidered, and that they be withdrawn.

6. In the outstanding Office Action, the Examiner alleged that Parrett teaches “a plurality of pull-up circuits each connected to one of the signal lines and isolated from the other pull-up circuits to prevent signals from the one or the signal lines passing through the pull-up circuit to another one of the signal lines...,” as recited by claim 1. In support the Examiner relied on the isolation disconnect circuits 12a-12g illustrated in FIG. 1A of Parrett. No explanation regarding why the Examiner believes the isolation disconnect circuits 12 of Parrett disclose the pull-up circuits of claim 1 was provided.

7. Parrett is directed to an in-line bus isolation circuit 12 that includes two communication ports. (*See*, Parrett at Abstract.) This isolation circuit 12 may be used to electronically isolate a SCSI device connected to a first port of the isolation circuit from other SCSI devices connected to the other port of the isolation circuit. (*See*, Parrett at Abstract.) Particularly, as shown in FIG. 1A of Parrett, one communications port of each isolation circuit 12 is connected to a bus portion (e.g., 11a) that is connected to a SCSCI device (e.g., a host computer 10 or peripheral device 13 (e.g. a disk drive)). The other communications port of each isolation circuit 12 is connected to a common bus portion 11c. (*See*, Parrett FIG. 1A.) The isolation circuits 12 are used to permit the corresponding SCSI device to communicate over the bus 11 or to isolate the SCSI device from other SCSCI devices connected to the bus 11. (*See*, Parrett at col.5 ln. 58- col. 6 ln. 23.) Thus, in the system of Parrett each isolation circuit 12 is connected to all signaling lines of the bus 11. Accordingly, the isolation circuits 12 of Parrett are not connected to a corresponding one of the signal lines of a bus, but instead are each connected to all signaling lines of the bus 11.

8. Applicants accordingly respectfully submit that Parrett fails to teach or suggest “a plurality of pull-up circuits, each connected to a corresponding one of the signal lines and isolated from the other pull-up circuits to prevent signals from the corresponding one of the signal lines passing through the pull-up circuit to another one of the signal lines...,” as recited by amended claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection to claim 1 for at least this reason.

9. Applicants further respectfully submit that the amended independent claim 1 is also allowable over Parrett for at least the following additional reason. As amended, independent claim 1 recites “a multi-mode power source configured to connect to an enable signal line of the bus, wherein the power source, in response to an enable signal carried on the enable signal line operates in one of at least a first and a second power mode, wherein in the first power mode the power source provides power at a particular voltage level to each of the plurality of pull-up circuits and wherein in the second power mode the power source does not provide power at the particular voltage level to the plurality of pull-up circuits.”

10. In the outstanding Office Action, the Examiner relied on the power supply 15 of Parrett as allegedly disclosing a multi-mode power source as recited in original claim 1. The Examiner provided no other explanation for the rejection. Parrett discloses that this power supply 15 supplies power to the isolation circuits 12 over power lines 15a. (*See*, Parrett at col. 5 lns. 61-63.) Parrett, however, does not teach or suggest that this power supply 15 is connected to the bus 11 let alone that the power supply 15 is responsive to an enable signal carried on a line of the bus 11.

11. Accordingly, Applicants respectfully submit that Parrett fails to teach or suggest “a multi-mode power source configured to connect to an enable signal line of the bus, wherein the power source, in response to an enable signal carried on the enable signal line operates in one of at least a first and a second power mode, wherein in the first power mode the power source provides power at a particular voltage level to each of the plurality of pull-up circuits and wherein in the second power mode the power source does not provide power at the particular voltage level to the plurality of pull-up circuits,” as recited by amended independent claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection to claim 1 for at least this additional reason.

12. Independent claims 15 and 18, as amended, includes similar recitations to the above-discussed recitations of independent claim 1. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to independent claims 15 and 18 for at least similar reasons to those discussed above.

13. Independent claim 22, as amended, recites, in part, “wherein the interface operates in one of a least a first power mode and a second power mode based on an enable signal

carried on the enable signal line of the bus; wherein, in the first power mode, the pull-up means provides a pull-up voltage to each of the signal lines; and wherein, in the second power mode, the pull-up means does not provide the pull-up voltage to the signal lines.” Applicants accordingly respectfully request that the Examiner reconsider and withdraw the rejection to independent claim 22 for at least similar reasons to those discussed above

14. Independent claim 32, as amended, recites, in part, “wherein the interface operates in either the first mode or the second mode based on an enable signal carried on the enable signal line of the bus.” Applicants accordingly respectfully request that the Examiner reconsider and withdraw the rejection to independent claim 32 for at least similar reasons to those discussed above.

15. Independent claim 42, as amended, recites, in part, “wherein the multi-mode power source operates in the first or second power modes based on an enable signal carried on the enable signal line.” Applicants accordingly respectfully request that the Examiner reconsider and withdraw the rejection to independent claim 42 for at least similar reasons to those discussed above.

***The Examiner has Failed to
Provide Evidence of a Motivation to Combine***

16. The §103 rejections are *prima facie* improper because they provide no appropriate basis for combining Parrett and Graves. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, ***either in the references themselves or in the knowledge generally available to one of ordinary skill in the art***, to modify the reference or to combine reference teachings (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must both be found in the prior art and not based on applicant’s disclosure*** (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

17. The Office Action attempts to justify combining Parrett with Graves based on unsupported conclusory statements. For example, in rejecting dependent claim 2 the sole justification for combining the references was as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions of Parrett and Graves in order to implement a pull-up circuit

consisting of a diode to isolate pull-up circuits from one another. The motivation to do so would be to have bus interface control that can isolate a bus without requiring extensive real estate on the board. (*See*, Office Action at pg. 8.)

18. The above quoted conclusory statement fails to properly identify any text in Parrett, Graves, or any other reference that would provide any motivation for combining Graves with Parrett.

19. Rather, this motivation appears to be taken directly from Applicants' specification. For example, page 2 lines 26-29 of Applicants' specification recites "There is, therefore, a need for a bus interface control that can selectively connect or isolate a board to or from a bus, without requiring as much board real estate as in conventional systems." The Examiner is reminded that the alleged motivation must be found in the prior art and that it is improper for the Examiner to engage in impermissible hindsight by relying on Applicants' teachings. *See, Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.)

20. As such, because the Examiner has failed to provide evidence of a motivation to combine Parrett and Graves, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections under §103 for at least this additional reason.

21. Further, if the Examiner is relying on his own personal knowledge to supply this missing motivation to combine the references, Applicant requests that the Examiner provide an affidavit as required under pursuant to 37 C.F.R. §1.104(d)(2) ("when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee").


Dependent Claims

22. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

23. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



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